

REMARKS

This Response is submitted in reply to the Final Office Action dated March 26, 2008 and in conjunction with the enclosed Request for Continued Examination. Applicant has amended claims 1, 10, 18, 29, 37, 48, 56 to 58, 62, 66, and 67. No new matter has been added by such amendments. A Supplemental Information Disclosure Statement is submitted herewith. Please charge Deposit Account No. 02-1818 for all payments due in connection with this Response and this Supplemental Information Disclosure Statement.

As noted above, Applicant has filed a Request for Continued Examination with this Response. Accordingly, Applicant requests that the Examiner provide an upcoming Office Action which will “. . . identify any claims which he or she judges, as presently recited, to be allowable and/or . . . suggest any way in which he or she considers that rejected claims may be amended to make them allowable” in accordance with §707.07(d) of the MPEP.

As a preliminary matter, the Interview Summary for the telephone interview on June 3, 2008 states that:

Applicant explained the limitations of the prior art and his independent claim. The applicant emphasized the value of displaying a plurality of offer components and component number modifiers which the Examiner disagrees with. However the applicant and the Examiner both agree that the prior art teaches the game play methodology, step 1 selecting an offer component through activation, step 2 displaying an award that is associated with the activated offer component, step 3 allowing a player to reject or accept the award, step 4 if rejected modifying the award with a component modifier which creates a new award based on the pervious [sic] award value.

Applicant respectfully disagrees and submits that no agreement was reached regarding the game play methodology of the prior art in relation to the claims of the present application.

The Office Action rejected Claims 1 to 4, 6 to 12, 14 to 21, 23 to 31, 33 to 40, 42 to 51, and 53 to 67 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Patent Application No. 2003/0036419 to Baerlocher et al. (“*Baerlocher*”).

Applicant disagrees with and traverses this rejection. Nonetheless, Applicant has amended certain of the claims for clarity.

Baerlocher discloses a gaming device which has award modification options for player selectable awards. The gaming device randomly generates a plurality of positions or digits of an award and enables the player to pick which position or digit receives a first randomly generated number, which digit receives a second randomly generated number, etc., until each of the positions have a number, whereby the gaming device determines the player's ultimate award based on the order of the number in the positions. In one version, the gaming device enables the player to decide whether to keep the currently generated award or risk the award and let the award modification take place. In another version, the gaming device automatically provides the award modification option to the player. In another version, the gaming device randomly generates one of the modification methods when the player decides to modify rather than keep a generated award. The modification methods include, among others: scrambling or rearranging the digits of an original award, completely regenerating the award, adding a digit to the award, subtracting a digit from the award and multiplying the award.

Amended independent Claim 1 is directed to a gaming device which includes, among other elements: a plurality of offer components, wherein each of the offer components has an activated and a deactivated state, a plurality of awards, wherein each of the awards has an award value and each of the awards is statically associated with one of the offer components for a play of a game, and a plurality of different displayed component number modifiers, wherein each component number modifier has a displayed value.

Applicant submits that support for each of the awards being statically associated with one of the offer components for a play of a game is disclosed in the specification at least on pages 21 to 27 and at least in Figures 3A to 3G. For example, in Figure 3A, the award of 1000 is associated with the offer component 102 for each point in the play of the game, as illustrated by Figures 3A to 3G. Similarly, each of the awards is associated with one of the offer components for each point in the play of the game (i.e.

each award of 1000, 500, 250, 100, 75, 50, 20, 10, 5, and 5 is associated with offer component 102, 104, 106, 108, 110, 112, 114, 116, 118, and 120, respectively, for each point of the play of the game, as illustrated in Figures 3A to 3G). Thus, the example illustrated in Figures 3A to 3G discloses that each of the awards is statically associated with one of the offer components for a play of a game.

As discussed during the telephone interview, *Baerlocher* does not anticipate or render obvious that each of the awards is statically associated with one of the offer components for a play of a game. That is, in *Baerlocher*, the value associated with one or more of the digits is modified when the award modification occurs. For example, if a first award of *Baerlocher* is 536 and the award is modified (i.e. rearranged or scrambled) to a second award of 653, then the value associated with the first or hundreds digit (i.e., first offer component) is modified from 5 to 6, the value associated with the second or tens digit (i.e., second offer component) is modified from 3 to 5 and the value associated with the third or ones digit (i.e., third offer component) is modified from 6 to 3. Similarly, if a first award of *Baerlocher* is 536 and the award is modified (i.e. subtract a digit) to 53, then the value associated with the first or hundreds digit (i.e., first offer component) is modified from 5 to 0, the value associated with the second or tens digit (i.e., second offer component) is modified from 3 to 5, and the value associated with the third or ones digit (i.e., third offer component) is modified from 6 to 3. Accordingly, in *Baerlocher*, the award values associated with each of the offer components are modified or changed as the game is played. On the other hand, amended independent Claim 1 is directed to a gaming device which includes a plurality of awards, wherein each of the awards is statically associated with one of the offer components for the play of the game. That is, in such a gaming device, the award value of each award remains associated with the same offer component for the play of the game and is not otherwise modified.

Moreover, the Office Action stated that *Baerlocher* fails to disclose a gaming device which contains only different modifying components associated with values and displays all of the modifiers at once. More specifically, the Office Action stated that:

the Office views the prior art's teaching of one modifying components associated with a value sufficient for one having ordinary skill in elementary math to include other mathematical operations that require values. Furthermore the Office views the limitation of a game containing only modifiers associated with a value then [sic] a mix of modifiers as taught by the prior art as mere design choice. Since the same problem of providing a consequence for rejecting an award is still solved by both games. Additionally the displaying of all possible modifiers at once to a player is also viewed as mere design choice since in both game [sic] the player has no say in which modifier will be used therefore each game takes a different approach on 'building suspense' as unknown (prior art) or identified (applicant) consequences.

Applicant disagrees and submits that a gaming device which includes a plurality of different displayed component number modifiers, wherein each component number modifier has a displayed value is substantially more than a simple design choice. *Baerlocher* discloses a gaming device which enables the player to decide whether to keep the currently generated award or risk the award and let the award modification take place. In one version, the *Baerlocher* gaming device automatically provides the award modification option to the player. In another version, the *Baerlocher* gaming device randomly generates one of the modification methods when the player decides to modify rather than keep a generated award. Under the Office Action's interpretation that the digits of *Baerlocher* are viewed as the offer components of amended independent Claim 1, *Baerlocher* does not anticipate or render obvious a plurality of different displayed component number modifiers, wherein each component number modifier has a displayed value. On the other hand, amended independent Claim 1 is directed to a gaming device which includes a plurality of different displayed component number modifiers, wherein each component number modifier has a displayed value.

It is improper for the Office Action to contend that prior art references do not disclose certain claimed elements and then simply state that these claimed elements are a simple design variation. Without providing any reference which discloses these claimed elements, any conclusions that such claimed elements are a simple design choice is impermissible. As stated in *In re Chu*, the finding of *In re Gal* is that "obvious design choice" is precluded where the claimed structure and the function it performs are

different from the prior art. *In re Chu*, 66 F.3d 292 (Fed. Cir. 1995); *In re Gal*, 980 F.2d 717 (Fed. Cir. 1992).

In this case, Applicant submits that a gaming device of *Baerlocher* which automatically provides the award modification option to the player or randomly generates one of the modification methods when the player decides to modify rather than keep a generated award, functions differently from the gaming device of amended independent Claim 1 which includes a plurality of different displayed component number modifiers, wherein each component number modifier has a displayed value, and a processor programmed to display a selection of at least one of the displayed component number modifiers. The possible award modifications of *Baerlocher* are not displayed to the player when the player decides whether to keep the currently generated award or risk the award to generate one of the award modification methods. On the other hand, the gaming device of amended independent Claim 1 displays each possible component number modifier and each value of each component number modifier when the player chooses to accept or reject the offer. Thus, the possible component number modifiers and the possible values of each component number modifier of the gaming device of amended independent Claim 1 are displayed to the player when the player decides whether to accept or reject the offer.

Moreover, such differences between the non-displayed modification methods of *Baerlocher* and the displayed component number modifiers and displayed component number modifier values of the gaming device of independent Claim 1 result in potentially influencing the player's decision regarding whether to accept or reject an offer. Thus, Applicant submits that the modification methods of *Baerlocher* and the displayed component number modifiers and the displayed component modifier values of the gaming device of independent Claim 1 function differently and the Office Action's conclusion of obvious design choice is precluded and improper.

Applicant also submits that it would not have been obvious to one of ordinary skill in the art to modify *Baerlocher* to result in such a gaming device without reasonably being construed as improper hindsight reconstruction. For at least these reasons, amended independent Claim 1 is patentably distinguished over *Baerlocher* and is in


condition for allowance. Claims 2 to 4 and 6 to 9 depend directly or indirectly from amended Claim 1 and are allowable for similar reasons, and because of the additional features recited in these claims.

Amended independent Claims 10, 18, 29, 37, 48, 56, 57, 58, 62, 66, and 67 each include elements similar to the elements of amended Claim 1 and are allowable for similar reasons. Claims 11, 12, and 14 to 17, Claims 19 to 21 and 23 to 28, Claims 30, 31, and 33 to 36, Claims 38 to 40 and 42 to 47, Claims 49 to 51 and 53 to 55, Claims 59 to 61, and Claims 63 to 65 depend directly or indirectly from Claims 10, 18, 29, 37, 48, 58, and 62, respectively, and are allowable for similar reasons, and because of the additional features recited in these claims.

An earnest endeavor has been made to place this application in condition for formal allowance, which is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

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